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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,588	09/05/2006	Xing Dong Wang	2006_1476A	3347

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EXAMINER	
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ART UNIT	PAPER NUMBER
1621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/591,588	WANG ET AL.	
	Examiner	Art Unit	
	LOUISA LAO	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 20-36* is/are pending in the application.

4a) Of the above claim(s) *16,18 and 25-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 17, 20-24 and 30-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/12/06 4/16/06 5/27/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 5/27/08, with respect to

a. the rejection(s) of claim(s) 19-24 under 35 U.S.C. 112, second paragraph have been fully considered, in light of the cancellation of claim 19 and amendments to dependent claims 20-24 and are persuasive. Therefore, the rejection has been withdrawn.

b. Applicants' reference to the following

> ***Specification***
> CROSS-REFERENCE TO RELATED APPLICATION
> This application is a 371 of PCT/JP05/03831 03/01/2005.

in the Office Action mailed 2/27/08 is a misunderstanding. There was no requirement that the specification would have the notation as stated above. The Office Action's reference was intended to acknowledge and cross-reference the priority to PCT/JP05/03831, as it was meant to be entitled "Priority" and not "Specification".

c. new method claims 30-36 are acknowledged; and are examined fully, in their entirety, in view of USC 112 issues and art rejections.

d. upon further consideration, the allowability of claims 1-15 and 17 is withdrawn, in light of new ground(s) of rejection, see below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-15 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the make/use of organic acid anion containing aluminum

salt hydroxide particles, of the formula (I) with substituents, where A is oxalic acid and B is sulfate, it does not reasonably provide enablement for the make/use of organic acid anion containing aluminum salt hydroxide particles, of the formula (I) with substituents, at least *any other* organic acid anions and for at least *any other* inorganic acid anion, as suggested by the breadth of the instant claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. The factors to be considered [in making an enablement rejection] have been summarized as a) the nature of the invention, b) the breadth of the claims, c) the state of the prior art, d) the relative skill of those in the art, e) the predictability or unpredictability of the art, f) the amount of direction or guidance presented, g) the presence or absence of working examples, and h) the quantity of experimentation necessary.

***a) the nature of the invention*:** the instant claims are drawn to a organic acid anion containing aluminum salt hydroxide particles, of the formula (I) with substituents defined therein,

b) *the breadth of the claims:* Independent claim 1's recitation of A and B substituents is extremely broad. The claims are interpreted to embrace any organic acid anion and any inorganic acid anion. The number of anions are large and equally the number of ensuing permutations thereto.

c&e) state and predictability of the art. The claimed compounds are novel. Hideyuki et al. (JP2000-007326, JP'326 *in IDS*) neither teach nor suggest the organic acid anion containing aluminum salt hydroxide particles, represented by general formula (I) in claim 1.

d)the relative skill of those in the art: the skill is high.

e&f)amount of guidance present and working examples. The instant disclosure provides guidance for the process of making organic acid anion containing aluminum salt hydroxide particles, of the formula (I) with substituents defined therein, where A is oxalic acid and B is sulfate. There is no guidance to make/use for at least any other organic acid anions and for at least any other inorganic acid anion, other than A is oxalic acid and B is sulfate. One species is not capable of encompassing the generic compound as recited in the breadth of the claims. There is no guidance to compounds that are purported to exhibit the same functionality as those shown using substituents, where A is oxalic acid and B is sulfate.

g) quantity of experimentation needed. The quantity of experimentation required of a person having ordinary skill in the art could potentially be infinite without further guidance. Without further guidance, a person of ordinary skill may have to experiment with different organic acid anions and other inorganic acid anion to determine the functionality of the compound described in the instant claim(s). All these elements taken into consideration make the experimentation unduly burdensome.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/use the full scope of the claimed invention without undue experimentation. In re Wright 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed.Cir.1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to practice Applicants' invention.

3. Claims 30-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of producing an organic acid anion containing aluminum salt hydroxide particles, of the formula (I) with substituents defined therein, where A is oxalic acid and B is sulfate, it does not reasonably provide enablement for a method of producing an organic acid anion containing aluminum salt hydroxide particles with at least any other organic acid

anions and for at least any other inorganic acid anion, as suggested by the breadth of the instant claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. The factors to be considered [in making an enablement rejection] have been summarized as a) the nature of the invention, b) the breadth of the claims, c) the state of the prior art, d) the relative skill of those in the art, e) the predictability or unpredictability of the art, f) the amount of direction or guidance presented, g) the presence or absence of working examples, and h) the quantity of experimentation necessary.

***a) the nature of the invention*:** the instant claims are drawn to a method for making organic acid anion containing aluminum salt hydroxide particles, of the formula (I) with substituents defined therein.

b) *the breadth of the claims:* Independent claim 30's recitation of A substituent is extremely broad. The claims are interpreted to embrace any organic acid anion. The number of acid anions are large and equally the number of ensuing permutations thereto.

c&e) state and predictability of the art. The claimed compounds are novel. Masahide et al. (JP64011638 *in IDS*), neither teaches nor suggests the method of producing organic acid anion containing aluminum salt hydroxide particles, which comprises *inter alia* the inclusion of both an organic acid anion and an inorganic anion salt. Hideyuki et al. (JP2000-007326, JP'326 *in IDS*) neither teach nor suggest the organic acid anion containing aluminum salt hydroxide particles, represented by general formula (I) in claim 1.

d)the relative skill of those in the art: the skill is high.

e&f)amount of guidance present and working examples. The instant disclosure provides guidance for the process of making organic acid anion containing aluminum salt hydroxide particles, of the formula (I) with substituents defined therein, where A is oxalic acid and B is sulfate. There is no guidance for the process of making organic acid anion containing aluminum salt hydroxide particles, of the formula (I) with substituents containing at least any other organic acid anions, other than A is oxalic acid. One species is not capable of encompassing the generic compound as recited in the breadth of the claims.

g) quantity of experimentation needed. The quantity of experimentation required of a person having ordinary skill in the art could potentially be infinite without further guidance. Without further guidance, a person of ordinary skill may have to experiment with different organic acid anions to determine the functionality of the compound described in the instant claim(s). All these elements taken into consideration make the experimentation unduly burdensome.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/use the full scope of the claimed invention without undue experimentation. In re Wright 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed.Cir.1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to practice Applicants' invention.

4. No claims are allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louisa Lao whose telephone number is (571)272-9930. The examiner can normally be reached from 8:00am to 8:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
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